

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of
Naoyuki ORII, et al.

Docket No: Q62820

Appln. No.: 09/769,392

Group Art Unit: 2155

Confirmation No.: 4710

Examiner: Bharat Barot

Filed: January 26, 2001

For: SYSTEM, METHOD AND STORAGE MEDIUM FOR DISTRIBUTING
INFORMATION USEFUL IN SPECIFIC AREA TO PORTABLE TERMINALS

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

In response to the Notification of Non-Compliant Appeal Brief mailed July 3, 2007,
Applicant respectfully submits an Amended Brief to correct the deficiencies in the original Brief.

Applicant respectfully submits that the Amended Appeal Brief complies with the rules
and therefore requests an Examiner's Answer.

Although Applicant believes that no fee is due, the USPTO is directed and authorized to
charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account
No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: August 2, 2007

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I.	REAL PARTY IN INTEREST	2
II.	RELATED APPEALS AND INTERFERENCES	3
III.	STATUS OF CLAIMS	4
IV.	STATUS OF AMENDMENTS	5
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER	6
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	9
VII.	ARGUMENT	10
VIII.	CONCLUSION	17
	CLAIMS APPENDIX.....	18
	EVIDENCE APPENDIX:	23
	RELATED PROCEEDINGS APPENDIX.....	24

I. REAL PARTY IN INTEREST

The real party in interest is NEC BIGLOBE, LTD. by virtue of an assignment executed by NEC Corporation (hereinafter “Appellant”) on August 21, 2006 and recorded in the U.S. Patent and Trademark Office on August 23, 2006 at reel 018155 and frame 0713.

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, there are no other prior or pending appeals, interferences or judicial proceedings known to Appellant's Representative or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in the Appeal.

III. STATUS OF CLAIMS

Claims 3, 5, 6, 9, 11, 12, 15, 17-19 and 25 are pending, stand rejected, and are the basis of this Appeal.

Claims 1, 2, 4, 7, 8, 10, 13, 14, 16 and 20-24 have been canceled, and are not the subject of this appeal.

See Claims Appendix for listing of claims.

IV. STATUS OF AMENDMENTS

Appellant amended claim 15 in the October 3, 2006 Amendment under 37 C.F.R. § 1.116. In the October 16, 2006 Advisory Action, the Examiner indicated that the amendments to claim 15 would be entered for purposes of appeal. Accordingly, all amendments, which have been made during prosecution of the present application, have been entered and are reflected in the attached Claims Appendix.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is directed to a method and system for distributing information on a shopping mall to portable terminals of customers. The features of independent claims 3, 9, 15 and 25 are described herein in reference to non-limiting embodiments of Appellant's specification.

Claim 3 - Claim 3 recites a system for distributing information on a shopping mall to portable terminals of customers. The system has a terminal 11 located in a store A1 in the shopping mall A operative to register in advance first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution (pg. 8, lines 2-27; pg. 9, lines 3-17). A means (processor 20 via terminal 40) for registering in advance preference information regarding each customer and a means (processor 20 via terminal 40 or GPS) for perceiving a customer's visit to the shopping mall (Fig. 1; pg. 10, lines 2-8; pg. 11, lines 5-12). Also, a means (processor 20) is provided for distributing, when the distributing time comes, only the items regarding the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting the shopping mall and for distributing the second information, differing from the first information, to portable terminals of customers not perceived to be visiting the shopping mall (pg. 10, lines 13-18; pg. 11, lines 12-27).

Claim 9 - Claim 9 recites a method for distributing information on a shopping mall to portable terminals of customers. The method comprises registering in advance, using a terminal

11 located in a store A1 in the shopping mall A, first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution (pg. 8, lines 2-27; pg. 9, lines 3-17). Preference information regarding each customer is registered in advance and a visit of the shopping mall by a customer is perceived (Fig. 1; pg. 10, lines 2-8; pg. 11, lines 5-12). When the distributing time comes, only the items regarding the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, is distributed to a portable terminal of the customer perceived to be visiting the shopping mall (pg. 11, lines 12-27). Further, the second information, which differs from said first information, is distributed to portable terminals of customers not perceived to be visiting the shopping mall (pg. 10, lines 13-18).

Claim 15 - Claim 15 recites a computer readable medium storing thereon a control program enabling a computer to execute an information distributing method to distribute information on a shopping mall to portable terminals of customers. The method involves registering in advance, using a terminal 11 located in a store A1 in the shopping mall A, first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution (pg. 8, lines 2-27; pg. 9, lines 3-17). Then preference information regarding each customer is registered in advance and a visit of the shopping mall by a customer is perceived (Fig. 1; pg. 10, lines 2-8; pg. 11, lines 5-12). When the distributing time comes, only the items regarding the attribute information of the store requesting the distribution matches

the preference information of the customer, out of the first information, are distributed to the portable terminal of the customer perceived to be visiting the shopping mall (pg. 11, lines 12-27). Finally, the program causes a computer to execute processing to distribute the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall (pg. 10, lines 13-18).

Claim 25 - Claim 25 recites a system for distributing information on a specific area to portable terminals. The system has a server E with a processor 20 (Fig. 1). The processor registers, in advance using a terminal 11 located in a store A1 in a shopping mall A, first information on the shopping mall, second information on the shopping mall, a distributing time of the first information and attribute information regarding each store in the shopping mall requesting distribution (pg. 8, lines 2-27; pg. 9, lines 3-17). The processor also registers, in advance, preference information regarding each customer (pg. 10, lines 2-8). The processor perceives a visit of the shopping mall by a customer, and distributes, at the distributing time, only information where the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall (pg. 11, lines 5-12; pg. 11, lines 12-27). The processor also distributes the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall (pg. 10, lines 13-18).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 are unpatentable under 35 U.S.C 102(e) in view of U.S. Patent No. 6,813,608 B1 to Baranowski et al (“Baranowski”).

B. Whether claim 19 is unpatentable under 35 U.S.C 103(a) in view of Baranowski.

VII. ARGUMENT

I. Preliminary Matter

As a preliminary matter, the Examiner rejected claims 15, 17-19 and 22 under 35 U.S.C. § 101 in the July 3, 2006 Final Office Action. In view of Appellant's amendment to claim 15, the Examiner indicated that the rejection was overcome. Accordingly, Applicant submits that the rejections under 35 U.S.C. § 101 are now moot and will not be discussed any further herein.

II. Rejections under 35 U.S.C. § 102(e) in view of U.S. Patent No. 6,813,608 B1 to Baranowski et al ("Baranowski")

The Examiner has rejected claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 under 35 U.S.C. § 102(e) as allegedly being anticipated by Baranowski.

A. Claim 3

Appellant submits that claim 3 is patentable over the cited reference. For example, claim 3 recites that "a terminal located in a store in the shopping mall operative to register in advance first information on the shopping mall, second information on the shopping mall.....regarding each store in the shopping mall requesting its distribution". Further the system comprises "*a means for distributing,the items.....out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall and for distributing the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall*".

In the system according to the present invention, the information to be distributed may either be extra-specific area information useful for urging customers outside the shopping mall to

come shopping or intra-specific area information useful for customers within the shopping mall to come shopping and the two types of the information are registered as differentiated from each other (non-limiting embodiment, page 9 lines 18-24 of specification). Thus, the present invention can provide an information distribution system without the problem of the *conventional system* in which the conventional system, “distributes information for mobilizing customers... *irrespective of where the individual customers are*” (emphasis added) (Page 1 lines 10-15 of specification).

The claimed second information is 1) registered by the terminal in a shopping mall and 2) distributed to portable terminals of customers, not perceived to be visiting said shopping mall. Appellant submits that Baranowski fails to disclose the second information. For example Baranowski discloses a web host which displays merchandise for sale and takes purchase orders. The merchandise can then be shipped to the customer, held for pick-up when the customer visits the wide-area facility or delivered to the accommodations of the customer within the wide-area facility at a specific time (Figures 1-5, Col. 14 lines 17-28). The web host, however, distributes the information *irrespective of where the customer is*. The information is only distributed based on the customer’s selection of the merchandise or order placement; the system does not pay any attention to the customer’s location before sending the information. Whether the customer accesses the web host at home or while in a mall, the information will still be the same.

Further Baranowski discloses that the web host distributes the information which may include reviews or information about the attractions of the wide-area facility, particularly those for which the customer made reservations. This information may also include weather forecasts for the day of the customer’s planned visit to the wide-area facility, industry news relevant to the

wide-area facility and similar facilities, or any other information that may be useful to the customer (Figures 1-5, Col. 15 lines 21-31) Similar to Appellant's comments above, however, the web host of Baranowski distributes the information *irrespective of where the customer is*. The information is distributed based only on the customer's *reservation* and the web host does not pay any attention to the customer's current location at the time of distributing the information. For example, the customer may make reservations for the next visit while the customer is still currently visiting the wide-area facility.

At least based on the foregoing, Appellant submits that claim 3 is patentable over Baranowski.

In the October 3, 2006 Amendment, Appellant requested the Examiner to point out the alleged "second information" in a more precise manner if the rejection of claim 3 was to be maintained. The Examiner did not provide the requested information in the attachment to the October 16, 2006 Advisory Action. Appellant again noted this request in the December 4, 2006 Pre-Appeal Brief Request for Review. For purposes of appeal, Appellant respectfully requests the Examiner to clarify this issue in a subsequent Examiner's Answer.

B. Claim 9

Since claim 9 contains features that are analogous to the features recited above for claim 3, Appellant submits that claim 9 is patentable for at least analogous reasons as claim 3.

More specifically, claim 9 recites a method that includes registering in advance, using a terminal located in a store in the shopping mall, first information on the shopping mall, second information on the shopping mall, regarding each store in the shopping mall requesting its distribution. Further the method includes distributing the items out of the first information to a

portable terminal of the customer perceived to be visiting the shopping mall, wherein the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting the shopping mall.

The claimed second information is 1) registered by the terminal in a shopping mall and 2) distributed to portable terminals of customers, not perceived to be visiting said shopping mall. Appellant submits that Baranowski fails to disclose the second information. For example Baranowski discloses a web host which displays merchandise for sale and takes purchase orders. The merchandise can then be shipped to the customer, held for pick-up when the customer visits the wide-area facility or delivered to the accommodations of the customer within the wide-area facility at a specific time (Figures 1-5, Col. 14 lines 17-28). The web host, however, distributes the information *irrespective of where the customer is*. The information is only distributed based on the customer's selection of the merchandise or order placement; the system does not pay any attention to the customer's location before sending the information. Whether the customer accesses the web host at home or while in a mall, the information will still be the same.

Further Baranowski discloses that the web host distributes the information which may include reviews or information about the attractions of the wide-area facility, particularly those for which the customer made reservations. This information may also include weather forecasts for the day of the customer's planned visit to the wide-area facility, industry news relevant to the wide-area facility and similar facilities, or any other information that may be useful to the customer (Figures 1-5, Col. 15 lines 21-31). Similar to Appellant's comments above, however, the web host of Baranowski distributes the information *irrespective of where the customer is*. The information is distributed based only on the customer's *reservation* and the web host does

not pay any attention to the customer's current location at the time of distributing the information. For example, the customer may make reservations for the next visit while the customer is still currently visiting the wide-area facility.

At least based on the foregoing, Appellant submits that the method according to claim 9 is not anticipated by Baranowski.

C. Claim 15

Since claim 15 contains features that are analogous to the features recited above for claim 3, Appellant submits that claim 15 is patentable for at least analogous reasons as claim 3.

More specifically, claim 15 recites a computer readable medium storing thereon a control program enabling a computer to execute an information distributing method to distribute information on a shopping mall to portable terminals of customers. The method includes processing to register in advance, using a terminal located in a store in the shopping mall, first information on the shopping mall, second information on the shopping mall, regarding each store in the shopping mall requesting its distribution. Further the method includes processing to distribute the items out of the first information to a portable terminal of the customer perceived to be visiting the shopping mall, wherein the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting the shopping mall.

The claimed second information is 1) registered by the terminal in a shopping mall and 2) distributed to portable terminals of customers, not perceived to be visiting said shopping mall.

As noted above, Baranowski fails to disclose the second information.

Similar to Appellant's comments above, the web host of Baranowski distributes the information *irrespective of where the customer is*. The information is distributed based only on the customer's *reservation* and the web host does not pay any attention to the customer's current location at the time of distributing the information. For example, the customer may make reservations for the next visit while the customer is still currently visiting the wide-area facility.

At least based on the foregoing, Appellant submits that the invention according to claim 15 is not anticipated by Baranowski.

D. Claim 25

Since claim 25 contains features that are analogous to the features recited above for claim 3, Appellant submits that claim 25 is patentable for at least analogous reasons as claim 3.

More specifically, claim 25 recites that a processor registers in advance a terminal located in a store in the shopping mall operative to register in advance first information on the shopping mall, second information on the shopping mall.....regarding each store in the shopping mall requesting its distribution". Further the processor distributes only information where the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting the shipping mall and distributes the second information, which differs from the first information, to portable terminals of customers not perceived to be visiting the shopping mall.

Appellant submits that Baranowski fails to disclose the second information for the reasons discussed above.

Further, Baranowski distributes the information *irrespective of where the customer is*.

At least based on the foregoing, Appellant submits that claim 25 is distinguishable from Baranowski.

E. Claims 5-6, 11-12 and 17-19

Since claims 5-6, 11-12 and 17-19 are dependent upon one of claims 3, 9 and 15, Appellant submits that such claims are patentable by virtue of their dependency therefrom.

F. Claim 22

Since Appellant previously canceled claim 22, without prejudice or disclaimer, the rejection of such claim is now moot.

III. Rejection under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,813,608 B1 to Baranowski et al (“Baranowski”)

The Examiner has rejected claim 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Baranowski.

A. Claim 19

Claim 19 recites a plurality of segments, each divided segment being recorded on one or another of a plurality of storage media. Appellant respectfully submits that claim 19 is patentable for at least the same reasons as claim 15, by virtue of its dependency therefrom.

Claim 19 is patentable because one would not have been motivated to modify Baranowski to include the missing features related to the second information discussed above. There is simply no teaching or suggestion for one of ordinary skill in the art to supplement the previously discussed deficiencies of Baranowski based on the disclosure of Baranowski.

Thus, claim 19 is not rendered unpatentable by Baranowski.

APPEAL BRIEF
U.S. Appln. No. 09/769,392

VIII. CONCLUSION

Applicant previously paid the \$500.00 fee for the Appeal Brief on February 28, 2007. Although Applicant believes that no fee is due, the USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: August 2, 2007

CLAIMS APPENDIX

CLAIMS 3, 5, 6, 9, 11, 12, 15, 17-19, 25 ON APPEAL:

3. (rejected): A system for distributing information on a shopping mall to portable terminals of customers, comprising:

a terminal located in a store in the shopping mall operative to register in advance first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution;

a means for registering in advance preference information regarding each customer;

a means for perceiving a visit of the shopping mall by a customer;

a means for distributing, when the distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall and for distributing the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall.

5. (rejected): The system, as claimed in claim 3, wherein:

said first information concerns a special sale, and customers are enabled to make an advance booking with a store by responding through said portable terminals.

6. (rejected): The system, as claimed in claim 3, wherein:

said first information concerns a degree of congestion at at least one of an attraction or a restaurant, and customers are enabled to make an advance booking with the attraction or restaurant by responding through said portable terminals.

9. (rejected): A method for distributing information on a shopping mall to portable terminals of customers, comprising:

registering in advance, using a terminal located in a store in the shopping mall, first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution;

registering in advance preference information regarding each customer;

perceiving a visit of the shopping mall by a customer; and

distributing, when the distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall;

wherein the second information, differing from said first information, is distributed to portable terminals of customers not perceived to be visiting said shopping mall.

11. (rejected): The method, as claimed in claim 9, wherein:

said first information concerns a special sale, and customers are enabled to make an advance booking with a store by responding through said portable terminals.

12. (rejected): The method, as claimed in claim 9, wherein:

said first information concerns a degree of congestion at at least one of an attraction or a restaurant, and customers are enabled to make an advance booking with the attraction or restaurant by responding through said portable terminals.

15. (rejected): A computer readable medium storing thereon a control program enabling a computer to execute an information distributing method to distribute information on a shopping mall to portable terminals of customers, the method comprising:

processing to register in advance, using a terminal located in a store in the shopping mall, first information on the shopping mall, second information on the shopping mall, distributing time of the first information and attribute information regarding each store in the shopping mall requesting its distribution;

processing to register in advance preference information regarding each customer;

processing to perceive a visit of the shopping mall by a customer; and

processing to distribute, when the distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to said portable terminal of the customer perceived to be visiting said shopping mall;

wherein said program causes a computer to execute processing to distribute the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall.

17. (rejected): The computer readable medium as claimed in claim 15, wherein:
said first information concerns a special sale, and said program causes a computer to execute processing to enable customers to make an advance booking with a store by responding through said portable terminals.

18. (rejected): The computer readable medium as claimed in claim 15, wherein:
said first information concerns a degree of congestion at at least one of an attraction or a restaurant, and said program causes a computer to execute processing to enable customers to make an advance booking with the attraction or restaurant by responding through said portable terminals.

19. (rejected): A plurality of grouped storage media wherein said program claimed in claim 15 is divided into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media.

25. (rejected): A system for distributing information on a specific area to portable terminals, comprising:

a server having a processor,

wherein the processor registers, in advance using a terminal located in a store in a shopping mall, first information on the shopping mall, second information on the shopping mall,

a distributing time of the first information and attribute information regarding each store in the shopping mall requesting distribution,

wherein the processor registers, in advance, preference information regarding each customer,

wherein the processor perceives a visit of the shopping mall by a customer,

wherein the processor distributes, at the distributing time, only information where the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting said shopping mall and distributes the second information, differing from said first information, to portable terminals of customers not perceived to be visiting said shopping mall.

APPEAL BRIEF
U.S. Appl. No. 09/769,392

EVIDENCE APPENDIX:

None

APPEAL BRIEF
U.S. Appln. No. 09/769,392

RELATED PROCEEDINGS APPENDIX

None